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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,447	12/31/2001	John J. Egan	361331-510A	4963
30623	7590	06/30/2004	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			DELACROIX MUIRHEI, CYBILLE	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,447

Applicant(s)

EGAN ET AL.

Examiner

Cybille Delacroix

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

The following is responsive to Applicant's election received Dec. 15, 2003.

Applicant's election of 3-benzyl-oxazol-3-ium and arteriosclerosis with traverse is acknowledged. Since, Applicant has not specifically argued the alleged errors in the election requirement, the election requirement is maintained for reasons already of record. Please note that the claims have been renumbered pursuant to Rule 126. Therefore, the election of "arteriosclerosis" applies to renumbered claim 9.

Group II, claims 8 and 10 are withdrawn from consideration. Claims 3, 4, 6 are withdrawn from consideration.

No prior art was found for the elected species. Therefore, the Examiner expanded the search to the non-elected species.

Claim Objection(s)

Claims 1 and 5 are objected to because of the following informalities: in claims 1 and 5, there appear "(....)" and "{....}" throughout the claims. Applicant is respectfully requested to delete these and replace them with the appropriate punctuation.

Appropriate correction is required.

Claim Rejection(s)—35 USC 112

Claim 9 provides for the use of a compound in the manufacture of a medicament, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite

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where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

For purposes of this office action, claim 9 will be interpreted as being a method of making a medicament.

Claim Rejection(s)—35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5, 7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominianni et al. (abstract).

Dominianni et al. disclose the compound 3-[2-(3,5-dimethoxyphenyl)-2-oxoethyl]-oxazolium bromide. This compound has hypoglycemic activity and may be useful as an oral hypoglycemic agent. The compound was fed orally to diabetic mice and the results demonstrated that the compound reduced glucose levels. Please see the abstract submitted herewith.

Dominianni et al. do not disclose a compound where one or more of the methoxy substituents are absent or that there may be additional substituents added (see claim 1, page 70). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compound of Dominianni as claimed because one of ordinary skill in the art would not expect minor substitutions to affect the overall properties of the compound. In other words, such a modification to the compound would have been motivated by the reasonable expectation that minor substitutions to the compound would not affect the glucose reducing property of the

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compound. Please note that like Dominianni, the claimed compound can be used to treat diabetes.

With respect to the formulation of the compound into a pharmaceutical composition, since Dominianni et al. disclose that the compound has hypoglycemic activity and it can be administered orally, it would have been obvious to one of ordinary skill in the art to formulate the compound into a composition using conventional pharmaceutical excipients that allow for oral administration.

Concerning renumbered claim 9, which recites the intended use of the medicament, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02. Please see MPEP 2111.03. In this case, the Examiner respectfully submits that the composition, which contains a species embraced by the claims would be capable of ameliorating arteriosclerosis.

Conclusion

Claims 1, 2, 5, 7, 9 are rejected.

Any inquiry concerning this communication should be directed to Cybille Delacroix-Muirheid at telephone number (571) 272-0572.

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CDM

June 28, 2004

Cybulski
Patent Examiner 1614